

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 92077.003US3									
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>August 12, 2009</u> Signature <u>/Jennifer A. Chick/</u> Typed or printed name <u>Jennifer A. Chick</u>	Application Number 09/864,389		Filed May 25, 2001								
	First Named Inventor Jacob RICHTER										
	Art Unit 3773		Examiner BUI, Vy Q.								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top;"><input type="checkbox"/> applicant/inventor.</td><td style="width: 50%; vertical-align: top;"><u>/Karen Axt/</u> Signature</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td style="vertical-align: top;"><u>Karen J. Axt</u> Typed or printed name</td></tr><tr><td style="vertical-align: top;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>63483</u></td><td style="vertical-align: top;"><u>212-504-6465</u> Telephone number</td></tr><tr><td style="vertical-align: top;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="vertical-align: top;"><u>12 August 2009</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.	<u>/Karen Axt/</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Karen J. Axt</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>63483</u>	<u>212-504-6465</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>12 August 2009</u> Date
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.											

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jacob Richter, et al. **Confirmation No.:** 1194
Serial No.: 09/864,389 **Group Art Unit:** 3773
Filed: May 25, 2001 **Examiner:** Bui, Vy Q.

Title: LONGITUDINALLY FLEXIBLE STENT

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Commissioner for Patents
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REMARKS - PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Official Action dated May 12, 2009, for the above-referenced application, applicants hereby submit the following Remarks in support of the Pre-Appeal Brief Request for Review. Claims 1, 3, 6, 8, 11, 26, 28, 42-47 and 49 are currently pending. The Examiner has rejected claims 1, 6, 11, 26, and 42-47 as being anticipated by, or in the alternative, as obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 7,204,848 (Brown et al). Further, the Examiner has rejected claim 49 as being unpatentable as obvious under U.S. Patent No. 6,776,793 (Brown et al) in view of U.S. Patent No. 6,179,868 (Burpee et al), and claims 3, 8 and 28 as obvious in view of Brown '793 in view of U.S. Patent No. 6,120,847 (Yang et al). Favorable reconsideration and allowance of this application is respectfully requested in view of the following.

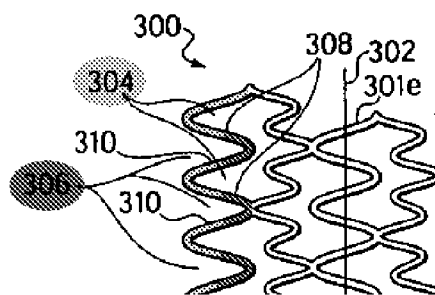
SUMMARY

The Examiner's rejection of the currently pending claims is based on an erroneous reading of both the present application and the cited Brown references (*i.e.*, Brown '848 and Brown '793, collectively "Brown"). Brown describes "band-like elements" and the present application describes and claims "loop containing sections" (or, alternatively, "circumferential bands"), which are sinusoidal circumferential structures. The Brown stents differ from the stents of the present application in that the Brown "band-like elements" are connected by intervening structures, whereas in the present application the "loop containing sections" and "circumferential bands" are joined without intervening structures. However, the Examiner has applied an arbitrary and unsupported definition of "band" that disregards both an essential feature of the Brown stent ("interconnecting members") and an essential recitation of the present claims (the joining of adjacent loop containing sections or bands without intervening materials). In view of the Examiner's misreading of both the present application and Brown, applicants respectfully submit that pending claims 1, 3, 6, 8, 11, 26, 28, 42-47 and 49 are allowable.

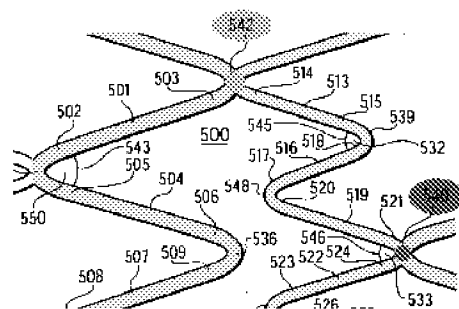
BACKGROUND

The currently pending claims are directed to a stent having a plurality of “circumferential bands” or “loop containing sections”, each formed of a “single, continuous, generally sinusoidal pattern” of loops. In all claimed embodiments, the circumferential bands or loop containing sections (collectively “alternating sinusoidal bands”) alternate between bands having struts of relatively lesser thickness and bands having struts of relatively greater thickness. Further, in all pending claims, the alternating sinusoidal bands are connected one to the other directly, without any intervening materials.

Alternating sinusoidal bands are described throughout the specification. For example, the second full paragraph of page 12 describes the vertical sinusoidal patterns or vertical loop containing sections (also referred to as “vertical sinusoids”) as “periodically interconnected” to form a stent, referencing Figure 3. These alternating sinusoidal bands are discussed further in the second full paragraph of page 8, which describes a pattern having “two loops 304 and 306 per period wherein loops 304 open to the right while loops 306 open to the left” found in Figure 3.¹ Thus, each vertical loop containing section is a single, continuous, generally sinusoidal pattern of loops, illustrated by Figure 3 at right.



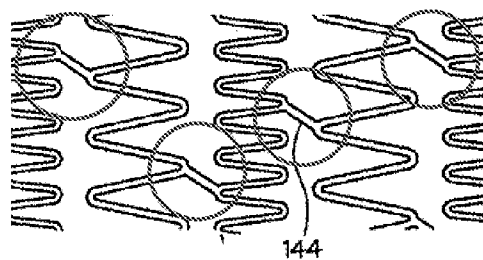
Further, the specification describes how alternating bands are joined without intervening materials. For example, the bottom paragraph of page 10 describes the “junction point[s]” 542 (green) and 540 (red) that define the direct points of connection between adjacent bands (blue and yellow), illustrated by Figure 4 at right.



¹ Applicant notes that present claim 11 incorporates both “circumferential bands” and “loop containing sections”. While the circumferential bands recited in claim 11 are each “formed of a single, continuous, generally sinusoidal pattern of loops”, as described above, the “first”, “second” and “third” loop containing sections together form a triangular cell. Thus, “loop containing section” is used and understood differently in claim 11 than in claims 1 and 49. As the Federal Circuit has observed, the same term may be used differently in the separate contexts of different claims of the same patent, provided that the “word or phrase used consistently throughout a claim [is] interpreted consistently.” See *Epcon Gas Systems, Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1030 -1031 (Fed. Cir. 2002) (emphasis in original); citing *Phonometrics, Inc. v. Northern Telecom Inc.*, 133 F.3d 1459, 1465 (Fed.Cir.1998). Here, the term “loop containing section” is used differently in the context of claim 11, which clearly distinguishes the “loop containing sections” that form a triangular cell with the “circumferential bands” that form “single, continuous, generally sinusoidal pattern[s] of loops.”

By comparison, Brown teaches a stent formed of “a plurality of interconnected band-like elements” and “interconnecting members which join adjacent bands.” (See Brown ‘848, 2:29-36; Brown ‘793, 2:30-37.) The “band-like elements” of the Brown stent are described as having “a generally serpentine configuration to provide continuous waves ... characterized by a plurality of peaks and troughs”. (See Brown ‘848, 5:37-46; Brown ‘793, 5:37-46.) As such, the “band-like elements” of Brown are equivalent to the “vertical loop containing sections” (or circumferential bands) of the present application. However, whereas the present application clearly describes alternating “loop containing sections” that are joined directly without intervening materials, the “band-like elements” of the Brown stent are in all cases joined by “interconnecting members” at circumferentially offset “peaks and troughs”. (See, e.g., Brown ‘848, 5:60-63, 6:31-33, 8:8-10, 9:27-29, 10:17-22, etc.)

In fact, every figure in Brown displaying a completed stent shows the “interconnecting members” joined to the “band-like elements” at offset “peaks and troughs” via a significant longitudinal and/or circumferential distance. See, for example, elements 144 (circled in red) illustrated in Figure 2 at right. See also structures 244, 244b, 344a, 344b, 444, 544, 644, 744, 844a, 844b, 944 and 1120.



Nothing in Brown teaches or suggests arranging alternating sinusoidal bands such that peaks and troughs are connected directly without intervening material. Indeed, the interconnecting members, whose ends are circumferentially offset, are essential structures that contribute to the alleged solution to the problem in the art of overlapping peaks and troughs. (See, e.g., Brown ‘848, 2:29-36) Thus, Brown cannot be said to teach or suggest a plurality of circumferential bands or loop containing sections (or “band-like elements”, to use the equivalent term from the Brown specification) joined one to the other (in other words, peak to trough) directly without intervening materials, as set forth in claims 1, 3, 6, 8, 11, 26, 28, 42-47 and 49 of the present invention, and in fact may teach away from such an arrangement.

ARGUMENT

The Examiner has rejected claims 1, 6 and 42-47 on the basis that Brown ‘848 teaches adjacent loop containing sections that are “directly joined” to one another under either 35 U.S.C. § 102 and § 103. However, to reach this conclusion, the Examiner defined the “band-like elements” in a manner inconsistent with the teachings of Brown. Specifically, the Examiner provided a diagram of Figure 2 of Brown ‘848 (illustrated at right) that identifies a “1st LCS (‘Loop Containing Section’) or 1st Band” that includes not only the aforementioned “band-like elements” taught by Brown ‘848 but also the “interconnecting elements” 144 (circled in red).

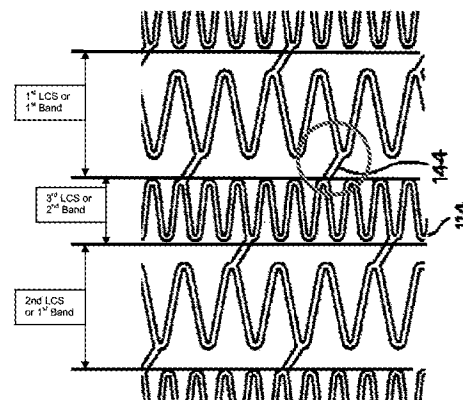
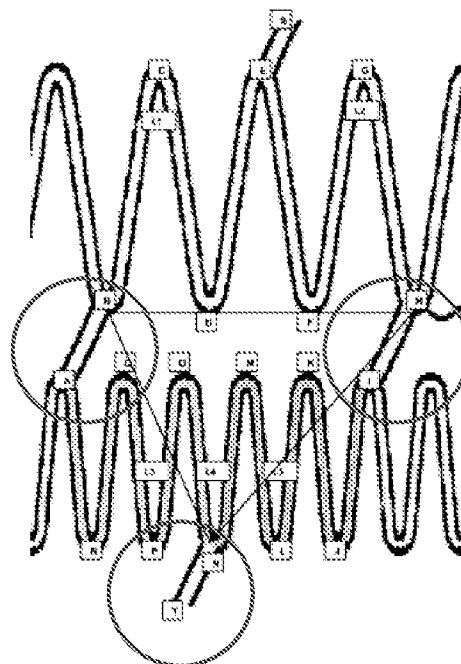


FIG. 2

Not only does the Examiner's definition of a 1st band contradict how the "band-like elements" are defined in Brown and eliminates the essential "interconnecting members" of Brown '848, but equating this alleged "1st band" with a "loop containing section" of the present specification also directly contradicts how a "loop containing section" is defined in the present specification and all pending claims: a single, continuous, generally sinusoidal pattern.

Because, Brown '848 does not teach or suggest adjacent circumferential bands or loop containing sections joined directly without intervening materials, it cannot anticipate claims 1, 6 and 42-47. Further, Brown '848 does not render claims 1, 6 and 42-47 obvious, because Brown '848 expressly teaches interconnecting members having ends offset in at least a circumferential direction as essential to the Brown invention.

The Examiner has also rejected claims 11 and 26 in view of Brown '848, relying on the same interpretation of "circumferential bands" discussed above. As noted, the Examiner defines interconnecting members (e.g., 144) not as distinct structures, as they are defined in Brown, but rather as an integral component of the generally serpentine configuration of the band-like elements. The Examiner then equates this conflated structure with the circumferential bands recited in claims 11 and 26. With reference to claim 11, the Examiner identifies an alleged "first loop containing section" ARQPON (blue) and "second loop containing section" NMLKJI (green). However, as shown to the right, the alleged "first" and "second loop containing sections" of Brown are not "defined by connection points to non-adjacent circumferential bands" as required by claim 11; instead they are defined by connection points to separate "interconnecting members" (circled in red).



With reference to claim 26, the Examiner again repeats the error by defining a first member ABC, second member CDE, third member EFG and fourth member GHI (meant to correspond with the first through fourth members of claim 26); however, the first through fourth members of claim 26 form "a portion of a first circumferential band formed of a single, continuous, generally sinusoidal pattern of loops." The alleged "first member" ABC and "fourth member" GHI include the circled "interconnecting elements" AB and HI, which as discussed above do not form a part of the "band-like elements" taught by Brown '848 that are the equivalent of the "single, continuous, generally sinusoidal pattern of loops" of the present application. Therefore, because Brown '848 does not teach or suggest either "first and second loop containing sections defined by points of connection to adjacent circumferential bands" or cells formed of first, second, third and fourth members that together form a portion of a circumferential band, Brown '848 cannot anticipate claims 11 and 26. Further, Brown '848 does not render claims 11

and 26 obvious because Brown '848 teaches that interconnecting members are an essential and separate structure intervening between the generally serpentine configurations of Brown, and if the interconnecting members were removed, the adjacent peaks and troughs would not be circumferentially offset as required by Brown.

Lastly, the Examiner has rejected claim 49 as obvious over Brown '793 in view of Burpee, and claims 3, 8 and 28 over Brown '793 in view of Yang. In both instances, however, the aforementioned deficiencies of Brown '793 (which has identical disclosures to Brown '848) are not remedied by the additional cited art because neither Burpee nor Yang teach or suggest adjacent alternating sinusoidal bands (referred to in claim 49 as "loop containing sections") formed of a "single, continuous generally sinusoidal pattern of loops" joined without intervening material. Claim 49 recites a stent consisting essentially of continuous generally sinusoidal loop containing sections joined one to the other, thereby excluding intervening material between adjacent loop containing sections. Thus, Brown '793 cannot render claims 3, 8 and 28 or claim 49 obvious in view of either Yang or Burpee, respectively.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request allowance of this application over the final Office Action of May 12, 2009.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Pre-Appeal Brief to Deposit Account No. 50-4387, Order No. 92077.003.

In the event that an extension of time is required, the Commissioner is requested to grant a petition for that extension of time to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment to Deposit Account No. 50-4387, Order No. 92077.003.

Respectfully submitted,
Cadwalader, Wickersham & Taft LLP

Dated: Aug 12, 2009

By:


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